

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		PC916.00 / 31132.154	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>August 17, 2007</u></p> <p>Signature <u>Bonnie Boyle</u></p> <p>Typed or printed name <u>Bonnie Boyle</u></p>		Application Number	Filed
		10/685,745	October 15, 2003
		First Named Inventor	
		Lukas Eisermann	
		Art Unit	Examiner
		3733	Pedro Philogene
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>47,684</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

Dustin T. Johnson
Signature

Dustin T. Johnson

Typed or printed name

972 739-6969

Telephone number

August 17, 2007

Date

☒ *Total of one (1) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Lukas Eisermann	§	Confirmation No.: 6136
	§	
Serial No.: 10/685,745	§	Group Art Unit: 3733
	§	
Filed: October 15, 2003	§	Examiner: Pedro Philogene
	§	
For: SEMI-CONSTRAINED AND	§	
MOBILE BEARING DISC	§	
PROSTHESIS	§	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS ACCOMPANYING PRE-APPEAL
BRIEF REQUEST FOR REVIEW

Dear Sir:

Please consider the following remarks in support of the concurrently filed Pre-Appeal Brief Request for Review.

I. Dependent Claim 12

Applicant submits that there is clear error with respect to the rejection of claim 12 under 35 U.S.C. § 102(b) under U.S. Patent No. 5,893,889 to Harrington. Applicant submits that the rejection of claim 12 is deficient because the Harrington patent clearly fails to disclose a dampening sleeve that “comprises shape memory alloys.”

The final Office Action dated May 24, 2007 asserts that such a limitation can be found in the Harrington patent at column 2, lines 55-67, column 3, lines 1-67, column 4, lines 1-50 (these make up the entire detailed description section) or in Fig. 2. Final Office Action, pg. 2. As stated in Applicant’s un-entered Reply to Office Action Under 37 C.F.R. § 1.116, filed July 3, 2007, at page 7, the Harrington patent fails to disclose any dampening sleeve that “comprises shape memory alloys” as recited in claim 12.

Thus, the rejection of claim 12 based on the recited combination appears to be clear error. Applicant's proposed amendment rewriting claim 12 in independent form was not entered.

II. Dependent Claim 13

Applicant submits that there is clear error with respect to the rejection of claim 13 under 35 U.S.C. § 102(b) under the Harrington patent. Applicant submits that the rejection of claim 13 is deficient because the prior art reference clearly fails to disclose a dampening sleeve "configured to produce a cavity for receiving a lubrication medium."

The final Office Action dated May 24, 2007 asserts that such a limitation can be found in the Harrington patent at column 2, lines 55-67, column 3, lines 1-67, column 4, lines 1-50 (these make up the entire detailed description section) or in Fig. 2. Final Office Action, pg. 2. As stated in Applicant's un-entered Reply to Office Action Under 37 C.F.R. § 1.116, filed July 3, 2007, at pages 7-8, the Harrington patent fails to disclose any dampening sleeve "configured to produce a cavity for receiving a lubrication medium" as recited in claim 13.

Thus, the rejection of claim 13 based on the recited combination appears to be clear error.

Applicant's proposed amendment rewriting claim 13 in independent form was not entered.

III. Independent Claims 1 and 27

Applicant submits that there is clear error with respect to the rejection of independent claims 1 and 27 under 35 U.S.C. § 102(b) under the Harrington patent. The rejection of claims 1 and 27 is deficient because the prior art clearly fails to disclose "an entirely spherical ball bearing."

The Office Action relies upon a ball fixed on the end of a post for a teaching of an entirely spherical ball bearing. However, as detailed in Applicant's un-entered Reply to Office Action Under 37 C.F.R. § 1.116, filed July 3, 2007, at pages 6-7, the device in the Harrington patent would be inoperable if it employed an entirely spherical ball bearing.

Thus, the rejection of claims 1 and 27 appears to be clear error.

Conclusion

For at least the reasons set forth above, Applicant submits that the application should be in a condition for allowance.

Respectfully submitted,



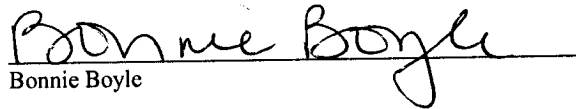
Dustin T. Johnson
Registration No. 47,684

Dated: August 17, 2007

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202 3789
Telephone: 972/739-6969
Facsimile: 214/651-5940
Client Matter No.: 31132.154
R173985

Certificate of Service

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on August 17, 2007.


Bonnie Boyle